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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,965	11/15/2000	David R. Scott	277-P-32-USA	5189

7590 02/08/2005

Drummond & Duckworth  
5000 Birch Street  
Suite 440 East tower  
Newport Beach, CA 92660

EXAMINER
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BLECK, CAROLYN M

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/713,965

Applicant(s)

SCOTT, DAVID R.

Examiner

Carolyn M Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Notice to Applicant*

1. This communication is in response to the amendment filed 9 December 2004. Claims 1-7 are pending. None of the pending claims have been amended.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3, and 5-7 are rejected under 35 U.S.C. 102(b) as being anticipated by Otis (L.H. Otis, *Insured Satellite 'Reboost' is a First*, National Underwriter, vol. 95, issue 16, April 1991, pp. 7-9), for the same reasons provided in the previous Office Action (paper 8/25/2004).

(A) Claims 1, 3, and 5-7 have not been amended and are rejected for the same reasons given in the prior Office Action (paper 8/25/2004; section 3(A)-3(E)).

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Otis (L.H. Otis, *Insured Satellite 'Reboost' is a First*, National Underwriter, vol. 95, issue 16, April 1991, pp. 7-9) as applied to claim 1, and further in view of Scott (5,806,802), for the same reasons provided in the previous Office Action (8/25/2004).

(A) Claims 2 and 4 have not been amended and are rejected for the same reasons given in the prior Office Action (paper 8/25/2004; section 5(A)-5(B)).

***Response to Arguments***

6. Applicant's arguments filed 9 December 2004 have been fully considered but they are not persuasive. Applicant's arguments will be addressed below in the order in which they appear in the response filed 9 December 2004.

(A) At pages 3-7 of the response filed 9 December 2004, Applicant argues that neither Otis or Scott disclose providing an insurance policy which provides for the guarantor initiating a recovery mission to recover a satellite and move the

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satellite from an unintended orbit to an intended orbit. Applicant further argues that the only reference pertaining to insurance, Otis, teaches providing money in the event of a satellite failure.

The Examiner respectfully submits that the prior art teaches the feature of “an insurance policy which provides for the guarantor initiating a recovery mission to recover a satellite and move the satellite from an unintended orbit to an intended orbit.” The Examiner submits that Otis discloses “obtaining a risk management package encompassing two separate but overlapping coverages in one policy, wherein the first portion of the coverage insures the satellite in low orbit and until its recovery by the NASA space shuttle, and wherein the second phase of coverage encompasses the operation of placing the satellite into the cargo hold of the space shuttle, refitting it with a new perigee motor, and the reboost of it into its final operational orbit (par. 7-8).” Further, Otis discloses that this coverage is structured for the in-space recovery and “reboost” of a satellite, which was disabled since its original launch because it was stuck in a non-operational lower orbit (par. 3-4).

With regards to Applicant's argument that the only reference pertaining to insurance, Otis, teaches providing money in the event of a satellite failure, the Examiner respectfully submits that all Applicant's claims require is the guarantor initiating a recovery mission. The claim does not recite that the guarantor performs the recovery mission (i.e., actually recovers the satellite). The claim simply requires “initiating the recovery mission.” The Examiner respectfully submits that “initiating the recovery mission” includes providing money in the

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event of a satellite failure. Furthermore, as discussed above, the Examiner submits that Otis clearly discloses initiating a recovery mission by utilizing a second phase of coverage which reboosts the satellite into its final operational orbit.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the guarantor recovering the satellite, or the guarantor performing the recovery mission) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will

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the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(703) 872-9306 or (703) 872-9326 [Official communications]

(703) 872-9327 [After Final communications labeled "Box AF"]

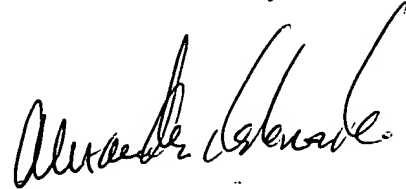
(703) 746-8374 [Informal/ Draft communications, labeled "PROPOSED" or  
"DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive, Arlington, VA, 7th Floor (Receptionist).

CB

CB

January 25, 2005



ALEXANDER KALINOWSKI  
PRIMARY EXAMINER